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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,699	12/09/2003	Darren A. Janzig	1023-331US01	3259
28863	7590	11/01/2006	EXAMINER	
SHUMAKER & SIEFFERT, P. A. 8425 SEASONS PARKWAY SUITE 105 ST. PAUL, MN 55125			MANUEL, GEORGE C	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/731,699	Applicant(s) JANZIG ET AL.	
	Examiner George Manuel	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1,3-15 and 17-25 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 1,3-15 and 17-25 is/are rejected.

7) ☐ Claim(s) ____ is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. ____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____.	6) <input type="checkbox"/> Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 6-12, 14, 18, 21-25 stand rejected under 35 U.S.C. §102(b) as being anticipated by Owens et al (US 4,972,846). Owens et al is considered to disclose:

a least two modules comprising patch electrodes 10 and 11, each of the modules comprises a respective one of at least two housings,

a coupling module comprising two lumens, lead wires 21 and 23, each of which comprises a co-axial lumen defined by structures 102 and 103 in Fig. 4 and generator 25 coupled to each of the modules, the coupling module defining at least one lumen between the housings, the examiner is interpreting the layer of PTFE 102 to comprise a lumen in which wire 101 is provided; this interpretation appears reasonable in view of Applicants' disclosure wherein the lumen permits components and elements in one module to be mechanically or electrically coupled to other components and elements in the other module,

an overmold comprising silicone boot 18 that at least partially encapsulates each of the housing and the coupling module (see Fig. 1),

the coupling module permits motion of the two modules along at least one axis of motion resulting from the motion of the heart.

Regarding claim 5, the examiner considers the generator 25 to comprise a control module.

Regarding claim 6, Owens et al teach the thickness of the outer insulating layer should be less than 0.1 mm which is less than Applicants' maximum thickness of between approximately 4 millimeters and approximately 8 millimeters.

Regarding claim 18, the examiner is interpreting the conductive epoxy 16 to comprise a weld joint.

Regarding claim 25, Owens et al teach hermetically sealing, see col. 6, lines 4-6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 15, 17 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Owens et al (US 4,972,846).

Regarding claims 13 and 15, one of ordinary skill in the art would have found it obvious to provide a bellow section or use a helical portion along the coupling module because these are well known stress reduction means used in wire extensions to reduce stress.

Regarding claim 17, one of ordinary skill in the art would have found titanium a well known and commonly used conductor suitable for the application of wire 101.

Regarding claim 20, one of ordinary skill in the art would have found it obvious to provide a battery power source to the generator 25 to power the second module because batteries are well known power sources for implantable defibrillator devices.

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Owens et al (US 4,972,846) in view of Kallok et al (US 4,499,907).

Owens et al show all of the claimed features except for a third module and a second coupling module.

Kallok et al teach using four electrodes to defibrillate a heart.

One of ordinary skill in the art would have found it obvious to combine the teaching of Kallok et al with the device of Owens et al to provide an additional electrode in a third module and a second coupling module to defibrillate a heart because the device of Owens et al is readily adaptable for adding additional electrodes and Owens suggests the Kallok et al reference is applicable by citing the reference in the background of the disclosure.

In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)

Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies in the joint, and a plurality of "ribs" projecting outwardly from each side of the web into one of the adjacent concrete slabs. The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/731,638. The two modules of the claimed application possess an identical housing to that of the copending application. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to provide an implantable medical device for implantation in the head of a patient with variations of a first and second module including a flexible overmold to cover the modules.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (571) 272-4952.


George Manuel
Primary Examiner
Art Unit: 3762